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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/027,160	12/20/2001	Kurt A. Estes	9793070-0439	1693

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SONNENSCHN NATH & ROSENTHAL
P.O. BOX 061080
WACKER DRIVE STATION
CHICAGO, IL 60606-1080

EXAMINER

WEBB, GREGORY E

ART UNIT	PAPER NUMBER
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1751

DATE MAILED: 10/29/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

9

Office Action Summary

Application No.

10/027,160

Applicant(s)

ESTES ET AL.

Examiner

Gregory E. Webb

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 October 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-78 is/are pending in the application.
- 4a) Of the above claim(s) 53-78 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-52 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Newly submitted claims 53-78 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: The applicant's newly added independent claims 53 and 66 define newly presented inventions not encompassed by the originally presented claims.
2. Originally presented claims and newly added claims are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the combination does not require either laundry or a laundry machine. Furthermore, the subcombination has separate utility such as a dishwashing apparatus which could not be performed by the combination as it does not require an apparatus for operation. Finally as the combination does not require the apparatus it can be used for cleaning other materials such as glass or semiconductors.
3. Furthermore, the applicant's newly added claim 53 is directed to an apparatus and newly added claim 66 is directed to an article.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 53-78 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 112

1. Claim 24 remains rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
2. It remains unclear to the examiner how light can be a "compound" in a detergent composition. The examiner refers the applicant to page 11 of the instant specification where the applicant refers to "ultraviolet light" as a "compound(s) that provide a deterative action". The term "compound" in chemistry refers to "a substance composed of atoms or ions." Clearly "ultraviolet light" does not meet the definition of a compound and thus renders claim 24 as indefinite.
3. It is again suggested that the term "ultraviolet light" either be corrected or removed from this claim.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 21-22, 25-38 remain rejected under 35 U.S.C. 102(b) as being anticipated by Maekawa et al (US 5,133,802).
6. Claims 40, 41, and 44-50 are rejected under 35 U.S.C. 102(b) as being anticipated by Maekawa et al (US 5,133,802).

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7. The applicant has included the requirement that the washing additive be non-aqueous. As the applicant has indicated that UV light qualifies as a non-aqueous additive. And as any composition would be exposed to UV light for at least a brief moment during formulation, such limitations as UV light are clearly met by this prior art reference. See arguments below for further details concerning the applicant's definition of UV light as a component in this composition.

8. Claims 21-22, 25-38 remain rejected under 35 U.S.C. 102(b) as being anticipated by Maekawa et al (US 5,133,802).

9. Claims 40, 41, and 44-50 are rejected under 35 U.S.C. 102(b) as being anticipated by Maekawa et al (US 5,133,802).

10. Claims 21-39 remain rejected under 35 U.S.C. 102(b) as being anticipated by Jackson et al (US 4,004,048).

11. Claims 39-52 are rejected under 35 U.S.C. 102(b) as being anticipated by Tokuyama (JP 405064521A).

12. The applicant has included the requirement that the washing additive be non-aqueous. The applicant has indicated in their arguments that UV light qualifies as a non-aqueous additive. And as any composition would be exposed to UV light for at least a brief moment during formulation, such limitations as comprising UV light are clearly met by this prior art reference. See arguments below for further details concerning the applicant's definition of UV light as a component in this composition.

Response to Arguments

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13. Applicant's arguments filed 10-7-02 have been fully considered but they are not persuasive.

14. Applicant argues the following points: 1) ultraviolet light can be incorporated into a cleaning composition; 2) fluorinated solvents do not meet the limitation of non-reactive, non-aqueous, non-oleophilic, and apolar; 3) Maekawa fails to teach which element is diluted; 4) Maekawa teaches aqueous dispersion and aqueous perfluorocarbons; 5) Maekawa teaches solid additives; 6) Jacksons chemicals are fixation agents and are reactive; 7) the recited compounds do not meet the limitations of claim 21; 8) Jackson fails to teach additives; 9) Jackson fails to teach a cosolvent; 10) Tomoyasu teaches aqueous compositions; 11) perfluorotripentylamine is not a working fluid.

15. Concerning the first point, ultraviolet light is not a chemical compound. If, however, we accept the applicant definition that describes brief contact with ultraviolet light as sufficient for meeting this additive limitation, then the examiner would argue that any natural light would also contain portion of ultraviolet light. Anyone making a composition in a well-lit room would inherently be adding ultraviolet light to their composition as described by applicant. As such, any composition compounded in anything but a dark cave would qualify to meet the applicant's ultraviolet light "compound." As the examiner is not aware of chemical formulators working in dark caves, any such composition would possess the additive "ultraviolet light" as defined in the applicant's response to the rejection. Clearly the prior art references meet the applicant's limitation to exposing the composition to ultraviolet light for even the briefest of moments. In this broadly defined limitation even the examiner, who is right now sitting in a well-lit room, must, as argued by applicant, comprise ultraviolet light. Furthermore as the examiner comprises

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non-reactive, non-aqueous, non-oleophilic, apolar compounds such as fatty compounds consumed during his lunch and as the examiner is sitting in a well-lit room, then apparently the examiner himself meets the limitations of the applicant's broadly defined claim 21.

16. Concerning the second argument, as fluorinated compounds have already been reacted with a very electronegative compound such as fluorine, the compounds would inherently be non-reactive. As these compounds don't contain water, they are inherently non-aqueous. As these compounds are perfluoro none of the carbon contain double bonds and would thus be non-oleophilic. As these compounds don't contain charge they are inherently apolar. Furthermore, as the applicant has not stated on record which specific property has not been met or how the prior art perfluorocarbons are different from the instant perfluorocarbons, the examiner does not consider this a strong argument.

17. The examiner disagrees with the third argument. The applicant's claims are directed to a composition. The prior art is also directed to a composition containing fluorinated solvents and additives. This combination of compounds is a composition. Maekawa teaches the dilution of these compositions (i.e. adding water). It is not clear why the applicant would confuse individual compounds with the diluted composition.

18. Concerning the fourth argument, again the applicant is again confusing compounds with compositions. The compound of Maekawa is a perfluoro amine. The compositions of Maekawa contain a perfluoroamine. The compositions are diluted. It is also unclear what the applicant means by the phrase "the perfluoroalkyl (sp) group taught in Maekawa is an aqueous dispersion." First, it is unclear how a chemical group could be an aqueous dispersion. Perfluoroalkyl groups

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are parts of a molecule. Parts of a molecule cannot be an aqueous dispersion. As such, the applicant's arguments are very difficult to interpret.

19. Concerning the fifth argument, the examiner clearly addressed claim 26 by stating "Maekawa further teaches the dilution of these composition with water." Water is a cosolvent as defined by the applicant's claim 26. The examiner knows of no other way to make this clearer to the applicant.

20. Concerning the sixth argument, the applicant has not excluded solid additives. In fact the applicant has expanded this definition to include massless objects moving at the speed of light which are also clearly not liquid.

21. Concerning the seventh argument, Jackson teaches perfluoroethers which as defined by applicant's claim 22 are non-reactive, non-aqueous, non-oleophilic, and apolar. First perfluoroethers have been reacted with fluorine. Such highly electronegative atoms will prevent further reaction at these sites. Perfluoroethers do not contain water and are thus non-aqueous. Perfluoroethers do not contain double bonds and are thus non-oleophilic. Perfluoroethers do not have a charge and are thus by definition apolar.

22. Concerning the eighth argument, any composition exposed to light now meets the applicant broad defined limitation wherein the additive is ultraviolet light. As very few compositions are formulated in the dark, these composition would be at some moment in time be exposed to light and would therefore meet the limitation of comprising and additive as described in the applicant's arguments.

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23. Concerning the ninth argument, as stated in the previous action, Jackson teaches ethers. Claim 26 clearly recites ethers. The examiner is at a loss of how he can explain this any more clearly to the applicant other than stating that "ethers are ethers."

24. Concerning the tenth argument, it is again noted that the applicant is confusing compounds with compositions. An aqueous composition can contain a compound that is non-aqueous. Here the aqueous composition of Tokuyama contains non-aqueous components. Similarly, the applicant's claimed composition can contain water as a co-solvent and would thus be an aqueous composition with non-aqueous components.

Conclusion

25. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory E. Webb whose telephone number is 703-305-4945. The examiner can normally be reached on 9:00-17:30 (m-f).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogendra Gupta can be reached on (703)308-4708. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9310 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0661.

A handwritten signature in black ink, appearing to read 'Gregory E. Webb', is written over the printed name and title.

Gregory E. Webb
Examiner
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gw
October 25, 2002